

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.	:	7,732,494	Confirmation No. 8005
Applicant	:	Yokoyama <i>et al.</i>	
Issue date	:	08 June 2010	
Appl. No.	:	10/548,407	
Filing or §371 date	:	08 September 2005	
TC/A.U.	:	1796	
Examiner	:	C. C. Wang	
Docket No.	:	TAN-354	
Customer No.	:	62,479	
Title	:	METHOD OF CONCENTRATING FINE PARTICLE DISPERSION AND METHOD OF RECOVERING FINE PARTICLE	

Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) awarded to U.S. Patent No. 7,732,494. Insofar as this petition requests reconsideration of the PTA for an incorrect calculation made regarding both the prompt Patent and Trademark Office responses guarantee and the three-year pendency period guarantee, it is timely filed pursuant to 37 C.F.R. § 1.705(d) within two months of the issue date. An increase of the total PTA calculation from 726 days to 764 days is respectfully requested. Please note the following:

Remarks begin on page 2 of this paper.

REMARKS

I. Determination of Patent Term Adjustment

Under 37 C.F.R. § 1.705(d), where the issued patent should have indicated a revised Patent Term Adjustment (PTA), a request for reconsideration of the PTA must be filed within two months of the issue date of the patent. The Patent Office computers calculate the time earned pursuant to 37 C.F.R. § 1.702(b) when the patent issues. Therefore, any additional “three-year” term adjustment is unlikely to appear on the Notice of Allowance but should be a revision reflected on the face of the issued patent. In addition, the same error underlying the miscalculation of the three-year term has caused a miscalculation of the period of adjustment awarded concerning the guarantee for prompt Patent and Trademark Office responses. Hence, Patentees seek to address both errors simultaneously. This petition requests reconsideration of the PTA for the lack of revision to PTA on the face of the issued patent and is timely filed pursuant to 37 C.F.R. § 1.705(d).

II. Measuring Patent Term Adjustment Periods

The Patent Term Adjustment (PTA) awarded to an issued patent is governed by 35 U.S.C. § 154(b)(1), which guarantees an adjustment of the patent term for delays falling under two periods: the “A delay” and the “B delay.” “A delay” is defined in 35 U.S.C. § 154(b)(1)(A) as the period of delay caused by the failure of the U.S. Patent and Trademark Office to meet certain administrative deadlines, such as the failure to mail at least one of a notification under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a) or fulfilled the requirements of 35 U.S.C. § 371 in an international application. “B delay” is defined under 35 U.S.C. §

154(b)(1)(B) as the term exceeding the guaranteed three-year application pendency period. The starting date for the “B delay period” for a national stage application is the date under 35 U.S.C. § 371 that the national stage was “commenced” under 35 U.S.C. § 371(b) or (f).

To the extent that the “A delay” and “B delay” periods overlap, any term adjustment shall not exceed “the actual number of days the issuance of the patent was delayed.” 35 U.S.C. § 154(b)(2)(A). The “A delay” and “B delay” periods of time overlap if they occur on the same calendar day. *See* Wyeth v. Dudas, 508 F. Supp. 2d 138, 141, 88 U.S.P.Q.2d 1538 (D.D.C. 2008), *aff’d by* Wyeth v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010). If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, then they do not overlap, and 35 U.S.C. § 154(b)(2)(A) does not limit the term adjustment to one day. *Id.*

III. Review of Patent Term Adjustment Calculation

Commencement of National Phase and Fulfillment of Requirements Under 35 U.S.C. § 371

The present application was filed on September 8, 2005. This initial filing contained a declaration signed by the inventors, a copy of the International Application (IA), an English translation of the IA, preliminary amendments, specification, claims, abstract, and the priority document. September 8, 2005 is unequivocally the “commencement” date of the § 371 application.

The official Filing receipt issued on February 2, 2006 indicated that the filing date under 35 U.S.C. § 371(c) is September 8, 2005. However, the Notice of Acceptance indicated that all of the § 371 requirements were completed on September 27, 2005. No filings were made by Applicant on that date. There is also no filing on that date entered in the Office’s electronic Image File Wrapper. The electronic file’s Transaction History does not reflect the originally filed documents but instead incorrectly lists September 27, 2005 as the “371 Completion Date.”

September 8, 2005 is the proper date for completion of all § 371 requirements, because this is the date that the required documents were filed in and received by the Office. Indeed, the face of the issued patent correctly indicates that the date under Sections 371(c)(1), (2), and (4) is September 8, 2005. Therefore, all PTA calculations should be made using September 8, 2005 as the starting date, and the periods of “A delay” and “B delay” should each be extended by 19 days.

A Delay

A first Office Action was due on or before November 8, 2006, which is the date that is fourteen months after the filing date of September 8, 2005. The Office mailed a Non-Final Rejection on June 25, 2008, thereby accruing an “A delay” term of 595 days. No other “A delay” periods were accrued due to Office delays during the pendency of the application. Accordingly, the total “A delay” for this patent should be calculated to be 595 days. Patentees dispute the Office’s calculation of this “A delay” period, which is 576 days. This 19 day difference is due to the error in the filing date entered into the computer program.

B Delay

The captioned patent was filed as U.S. Patent Application Serial No. 10/548,407 under 35 U.S.C. § 371 on September 8, 2005. September 9, 2008 is the day after the date that is three years from the filing date. The patent issued on June 8, 2010. The three-year “B delay” period terminated prior to issuance of the patent with the filing of a Request for Continued Examination (RCE) on June 10, 2009. *See* 37 C.F.R. § 1.703(b)(1). The period of time beginning on September 8, 2008 and ending on June 9, 2010 is 274 days. The Office calculated 255 days of “B delay” for issuance of the patent more than three years after the filing date, taking into account the RCE filed. Patentees respectfully submit that the Office’s calculation of the “B

delay” is incorrect and that the correct time period occurring after the guaranteed three-year pendency term is 274 days.

Overlap of “A delay” and “B delay”

There is no overlap between the periods of “A delay” and “B delay.”

Applicant Delay

An Applicant Delay period of 92 days was calculated by the Office covering the period in which Patentees failed to timely respond to a Final Rejection. An Applicant Delay period of 13 days was also assessed for failure to timely respond to a Non-Final Rejection issued after the filing of the RCE. Patentees were granted an extension of time for their late responses. Thus, the total period of Applicant Delay accrued is 105 days. Patentees do not dispute the Office’s calculations.

Terminal Disclaimer

U.S. Patent 7,732,494 is not subject to a terminal disclaimer.

IV. Conclusion

In light of the foregoing, Patentees submit that the PTA calculation of 726 days is incorrect. Accordingly, Patentees respectfully request reconsideration of the PTA as follows:

- (1) Total Office delay should be calculated to be 869 days, which is the sum of 595 days of “A delay” and 255 days of “B delay” minus 0 days for overlap.
- (2) The total Applicant Delay period should be calculated to be 105 days.
- (3) The total PTA should be entered as 764 days, which is calculated as the period of Total Office delay of 869 minus 255 days of Applicant Delay.

The required fee of \$200 under 37 C.F.R. § 1.18(e) is submitted herewith. The Commissioner is authorized to charge any additional required fees or credit any overpayment to Deposit Account No. 50-3913.

Respectfully submitted,
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